Applicant : Marilyn E. Shade, et al.
Serial No. : 09/963,876
Filed : September 25, 2001
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Attorney's Docket No.: 07844-470001 / P434

## REMARKS

Claims 1-10 were pending at the time of examination. Claims have been amended for clarification. No new matter has been added. The applicant respectfully requests reexamination in view of the amended claims and these remarks.

### I. The § 102 Rejections

The Examiner rejected claims 1, 4, 5, and 8-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,330,577 to Kim ("Kim"). The applicant respectfully traverses the rejection.

As to claim 1, the examiner asserts that the elements "displaying a sample window containing sample text using the composite font, and wherein an icon is provided for controlling display/non-display of at least one reference line associated with the font of the sample text displayed in the sample window" are present in Kim, citing Fig. 5. A copy of this figure is reproduced below for the convenience of the Examiner. Clearly, the figure does not disclose an icon for controlling display/non-display of at least one reference line, as required by claim 1.

FIG. 5
(Prior Art)
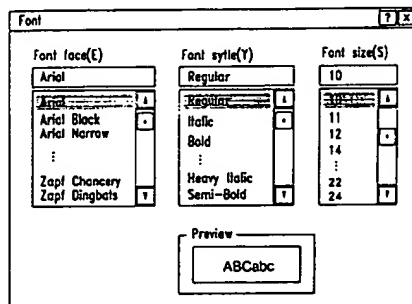


Reference lines are defined in the application (p. 7, lines 3-14) as illustrating to the user some aspects of digital fonts, including "embox, ICF box, baseline, cap height, ascent, descent, ascender, X height, and so on." Icons are illustrated in Fig. 4 of the application, items 28a *et seq*. For at least the foregoing reasons, claim 1 is allowable.

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As to claim 4 , the examiner asserts that the step of displaying "sample text ... in a sample window in a plurality of lines", as now recited in claim 4, is inherent in Kim. For inherency to exist, it must be clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *See, In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The examiner has not shown that the feature recited in claim 4 is necessarily present in Kim. For at least this reason, claim 4 is allowable. In addition, claim 4 depends from claim 1 and is allowable for that reason as well.

Claim 5 was rejected as being anticipated by Kim. Claim 5 recites a "reference line icon provided in the composite font editing dialog box" and the display of a reference line. As explained above in reference to claim 1, the claim elements are not found in Kim. For at least this reason, claim 5 is allowable.

Claim 8 was rejected as being anticipated by Kim. Claim 8 depends from claim 5 and is allowable for that reason. Claim 8 contains limitations similar to the limitations of claim 4, and the same inherency rejection was made. For the additional reasons set forth above in reference to claim 4, the inherency rejection is improper and claim 8 is allowable.

Claim 9 was rejected as being anticipated by Kim. Claim 9 contains limitations corresponding to those of claim 1, and claim 9 is allowable for the reasons set forth above in reference to claim 1.

Claim 10 was rejected as being anticipated by Kim. Claim 10 contains limitations corresponding to those of claim 5, and claim 10 is allowable for the reasons set forth above in reference to claim 5.

## II. The § 103 Rejections

The Examiner rejected claims 2, 3, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Kim and further in view of U.S. Patent 6,426,751 to Patel, et al. ("Patel"). The applicant respectfully traverses the rejection.

As to claim 2, the examiner asserts that Patel teaches reference lines selected from: "ICF box (average type face), embox (virtual body), baseline, cap height, ascent / descent, ascender, and X height." In fact, Patel does not teach reference lines at all. Patel teaches computer

software that "process[es] a front-end editable text file ... that a user ... can use to define changes to an existing font file ... or to create a font file." (col. 1, lines 44-48) That is, Patel does not teach any kind of graphical user interface whatsoever, let alone an interactive method of creating composite fonts using reference lines. Patel teaches a method of using text files to create fonts. "Font features are specified using an English-like grammar in a data file which may be created and modified using any text editor." (col. 2, lines 40-42) For at least the foregoing reasons, claim 2 is allowable. Moreover, claim 2 depends from claim 1 and is allowable for that additional reason.

Claim 3 was rejected as being unpatentable over Kim in view of Patel. The examiner asserts that the limitation "each reference line is displayed in a different color when a plurality of the reference lines is displayed" is obvious because WordPerfect 8 provides different types of fonts and different colors for fonts. The applicant respectfully submits that it is irrelevant whether the font itself can be displayed in different colors, because reference lines illustrate aspects of the font and are not characters of the font itself. For at least the foregoing reasons, claim 3 is allowable. Moreover, claim 3 depends from claim 2 and is therefore allowable for that additional reason.

Claim 6 was rejected by the examiner as being unpatentable over Kim in view of Patel. Claim 6 contains limitations similar to the limitations of claim 2. The claim elements that the examiner asserts to be in Patel, the applicant respectfully submits, are not in Patel, as set forth in the discussion of claim 2 above. For at least the foregoing reasons, claim 6 is allowable. Moreover, claim 6 depends from claim 5 and is therefore allowable for that additional reason.

Claim 7 was rejected as being unpatentable over Kim in view of Patel. Claim 7 contains limitations similar to the limitations of claim 3. The claim elements that the examiner asserts to be in Kim, the applicant respectfully submits, are not in Kim, as set forth in the response for claim 3. For at least the foregoing reasons, claim 7 is allowable. Moreover, claim 7 depends from claim 6 and is therefore allowable for that additional reason.

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Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _15 Dec 03_

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